

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEYUKI TERANE

Appeal No. 1998-0496
Application 08/356,966

HEARD: FEBRUARY 24, 2000

Before KRASS, JERRY SMITH and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-11, which constitute all the claims in the application. An amendment after final rejection was filed on January 2, 1997 but was denied entry by the examiner.

The disclosed invention pertains to a method and apparatus for processing signals. The invention has particular disclosed utility in the decoding of variable length Huffman codes for use in performing transformations in the restoration of received image data.

Representative claim 1 is reproduced as follows:

1. A signal processing device for processing an input signal including a plurality of first digits and a plurality of second digits, wherein the plurality of first digits indicate a run length of a single first value, and wherein the plurality of second digits include at least one second value other than said first value, said signal processing device comprising:

(a) an address generator comprising:

(a-1) a first input for sequentially receiving a run length indicative of a number of contiguous first values in said input signal;

(a-2) a second input for sequentially receiving said second digits;

(a-3) a first output for sequentially outputting a first address updated by a value of said run length plus one; and

(a-4) a second output for sequentially outputting said second digits in synchronism with a first address, and

(b) a signal processor for performing a predetermined signal processing upon said first address and said second digits to output an array of output signals.

The examiner relies on the following references:

Saito et al. (Saito)	5,184,229	Feb. 2, 1993
Fukuda et al. (Fukuda)	5,416,854	May 16, 1995
		(filed July 30, 1991)

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Saito. Claims 2-6 and 8-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Saito and Fukuda.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Saito does not fully meet the invention as recited in claims 1 and 7. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the

obviousness of the invention as set forth in claims 2-6 and 8-11. Accordingly, we reverse.

We consider first the rejection of independent claims 1 and 7 as being anticipated by the disclosure of Saito. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to each of claims 1 and 7, the examiner indicates how he reads these claims on the disclosure of Saito on page 3 of the answer. Appellant points primarily to the elements labeled "(a-3)" and "(a-4)" in claim 1 and the steps labeled "(c)" and "(d)" in claim 7 as claim recitations which are not met by Saito. According to appellant, what the examiner identifies in Saito as generating an address by updating a first address by a value of the run length plus one does not in fact meet the recitation of claims 1 or 7 [brief, pages 4-7]. The examiner has

indicated that the "run length plus one" of the claims is met by the overflow in Saito [answer, page 3] or by the non-zero amplitude digits of Saito [id., page 6].

We base our decision essentially on the arguments presented by appellant in the briefs. We agree with appellant that neither the overflow in Saito nor the non-zero digits in Saito are combined with the run length in Saito to generate sequential updated addresses which meet the limitations of claims 1 or 7. The examiner's mere assertion that the recitations of claims 1 and 7 are fully met by the disclosure of Saito is simply unsupported by the Saito disclosure.

Since we agree with appellant that every limitation of claims 1 and 7 is not fully disclosed by Saito, we do not sustain the examiner's rejection of claims 1 and 7 under 35 U.S.C. § 102.

We now consider the rejection of claims 2-6 and 8-11 under 35 U.S.C. § 103 as unpatentable over the teachings of Saito and Fukuda. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073,

5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the

evidence as a whole and the relative persuasiveness of the arguments. See Id.;

In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Claims 2-6 and 8-11 depend from either claim 1 or claim 7. The examiner relies on Saito for teaching all the limitations of claims 1 and 7 as noted above. The Fukuda reference does not overcome the deficiencies in Saito that were discussed above. Thus, there are differences between the claimed invention and the teachings of Saito and Fukuda which have not been properly addressed by the examiner. The failure to address the obviousness of these differences between the claimed invention and the applied prior art results in a failure to properly establish a prima facie case of obviousness. As noted above, the failure to make the prima facie case of obviousness by the examiner must result in a reversal of the rejection made under 35 U.S.C. § 103.

Appeal No. 1998-0496
Application 08/356,966

In conclusion we have not sustained either of the examiner's rejections of the claims. Therefore, the decision of the examiner rejecting claims 1-11 is reversed.

REVERSED

Errol A. Krass)	
Administrative Patent Judge)	
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Jerry Smith)	BOARD OF PATENT
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Appeal No. 1998-0496
Application 08/356,966

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